

In re)
)
) Decision on JUL 14 1999
) Petition for Review
) Under 37 C.F.R. § 10.2(c)
)

(Petitioner) seeks review of the decision on the Petition to Waive or Suspend the Examination Requirement for Registration by the Director of the Office of Enrollment and Discipline (Director), dated April 2, 1999. The Director's decision denied petitioner's request to waive the requirement in 37 C.F.R. § 10.7(b) that applicant take and pass the examination for registration. The petition is denied.

Petitioner asserts that she has taken the examination for registration a number of times and has passed both the morning and afternoon sections of different examinations. Petitioner further states that she was not granted a license because she did not meet the requirement of passing both sections of the examination within the “three-year” window, which was a grace period that was in effect prior to the August 1998 examination. Petitioner has not identified when she previously took and passed any portion of the registration examination and has submitted no evidence to support her claims either with her original petition or with this petition for review. Petitioner’s original petition asked the Director to waive the requirement that applicants must sit and pass both sections of the registration examination within a “three year” window.

In her April 2, 1999, final decision, the Director denied petitioner's request to waive the rules on the grounds that petitioner had not presented any argument which demonstrated that her situation was extraordinary, such that justice required waiver of the rules that applicant take and pass the examination for registration set forth in 37 C.F.R. § 10.7(b), under applicable requirements set forth in the bulletin entitled General Requirements For Admission to the Examination for Registration to Practice in Patent Cases Before the U.S. Patent and Trademark Office ("General Requirements" bulletin).

Both Petitioner and the Director refer to the "three-year window" within which applicants must take and pass both portions of the registration examination. This refers to a previous, now abandoned, grace period set forth in the General Requirements bulletin for examinations given prior to August 26, 1998, which reads in relevant part:

The examination for registration consists of two parts, a morning section and an afternoon section. To pass the examination, you must pass both sections. If you pass one section of the examination, but fail the other section, you will not be required to retake the section passed, provided you take and pass the section failed in one of the next three examinations scheduled by the U.S. Patent and Trademark Office. If you do not pass the section failed in one of the next three scheduled examinations, you will be required to retake both sections of the examination.

General Requirements Bulletin, 1997, at page 4 (emphasis added). Thus, the "three-year window" is actually a "three-examination" grace period applicable only to examinations taken prior to August 1998.

PTO changed its policy eliminating the "three-examination" grace period, as announced in the General Requirements bulletin for the August 26, 1998, examination which states in relevant part: "Anyone who has not passed both sections of the examination prior to or upon taking the

August 1998 examination will be required to retake the entire examination, including any section passed.”

In the present petition for review, Petitioner states that she “has passed both sections of the agency examination prior to August 1998 and is requesting that the ‘three year window’ requirement be waived so that Applicant may receive her license.” Accordingly, Petitioner is effectively requesting that the requirements of 37 C.F.R. § 10.7(b), requiring all applicants to take and pass the examination, be waived.

Opinion

The Commissioner has authority to establish regulations governing “the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office [“PTO”].” See 35 U.S.C. § 31; Premysler v. Lehman, 71 F.2d 387, 389, 37 USPQ2d 1057, 1059 (Fed. Cir. 1995). PTO regulations provide that an applicant will not be registered to practice before the Office unless he or she is “[p]ossessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants for patents valuable service.” 37 C.F.R. § 10.7(a)(2)(ii). The rules further provide that to establish such qualifications, “each applicant for registration must take and pass an examination which is held from time to time,” unless they fall within the specified exception to the rule of having actively served in the patent examining corps for at least four years. 37 C.F.R. § 10.7(b). The General Requirements bulletin provides the PTO’s interpretive rules regarding the registration examination. Premysler, 71 F.2d at 389, 37 USPQ2d at 1059.

In this case, Petitioner admittedly did not comply with the applicable regulations because she had not successfully taken and passed the registration examination prior to August 1998,

within the “three-examination” grace period as required by 37 C.F.R. § 10.7(b) and the General Requirement’s bulletin. Petitioner continues to seek waiver of the former “three-examination” grace period under 37 C.F.R. § 10.170. However, in order to be accorded the waiver, Petitioner must establish “an extraordinary situation, when justice requires” such a waiver. 37 C.F.R. § 10.170. Ordinarily, this requires a showing that circumstances exist which were unavoidable or unforeseeable, and not the result of a party’s own actions, where no other appropriate course of action for relief exists. See Margolis v. Banner, 599 F.2d 435, 439, 202 USPQ 365, 370 (CCPA 1979) (extraordinary circumstances existed sufficient to grant writ of mandamus where no other avenue of review was available); Helfgott & Karas v. Lehman, 1998 U.S. Dist. LEXIS 19898, *20 (S.D.N.Y. Dec. 22, 1998) (Commissioner did not abuse his discretion in refusing to waive applicable rules because no extraordinary circumstances existed where petitioner’s own actions contributed significantly to the alleged error), appeal pending, no. 99-1308 (Fed. Cir.).

Petitioner has not asserted any facts to demonstrate that her situation is “extraordinary” such that justice would require waiver of the rules. The assertion that she has “exam anxiety” and trouble with multiple choice examinations alone does not rise to the level of an “extraordinary” circumstance. Nor does the assertion that she would “very much like to be able to practice patent law” provide sufficient reason to waive the requirement of 37 C.F.R. § 10.7(b) that all applicants must take and pass the examination. Most importantly, however, Petitioner has alternative remedies available to her. Namely, she may apply to take the next examination and possibly obtain a passing score. See In re Klein, 16 USPQ2d 1965, 1966 (Comm’r Dec. 1990) (denying waiver under 37 C.F.R. § 10.170(a) of rules setting forth conditions for reinstatement despite hardship to petitioner of satisfying those preconditions). Accordingly, Petitioner has not alleged

any circumstances rising to the level of such an "extraordinary situation" which would require waiver of the rules.

Alternatively, Petitioner has failed to prove that she otherwise satisfies the necessary qualifications set forth in 37 C.F.R. § 10.7(a), without passing the examination. The patent laws and regulations governing practice before the PTO are subject to ongoing changes and development. In order to be able to "render applicants for patents valuable service," a practitioner must be able to establish that they are familiar with such laws and regulations and current Office practice. Petitioner fails to explain how passing portions of the examination during an unspecified time period of more than three years, sometime prior to 1998, establishes that she is sufficiently familiar with current law and practice to render such valuable service to applicants.

Petitioner's other arguments concern the Director's comments on changing the standard for registration. Petitioner misses the point. As discussed above, granting of a waiver requires a showing of an extraordinary situation, which was not done on the facts assumed here. It is noted that Petitioner has presented absolutely no evidence to support her arguments that she meets the necessary qualifications for registration.

CONCLUSION

Petitioner's request to waive rule 37 C.F.R. § 10.7(b) requiring all applicants to take and pass the examination is denied.

ORDER

Upon consideration of the petition to the Commissioner, it is
ORDERED that the petition is denied.

A handwritten signature in black ink, appearing to read 'Q. Todd Dickinson', is written over a horizontal line.

Q. Todd Dickinson

**Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks**

cc:

**Karen L. Bovard
Director, OED**